

REMARKS

Reconsideration of this application is respectfully requested. In response to the Non-Final Office Action ("Action") mailed December 30, 2005, Applicants submit the following. ~~Claims 1-28 are pending.~~

Based on the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

Double Patenting Rejection

On pages 2-4, the Action provisionally rejects claims 1, 3, 6, and 8 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 5, 6, and 10 of copending application no. 09/883,303.

Page 2 of the Action states:

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

On February 23, 2005, Applicants submitted a Terminal Disclaimer stating that this application and 09/883,303 are commonly owned. Accordingly, Applicants believe that the double patenting rejection is improper. Applicants respectfully request that the double patenting rejection be withdrawn.

Rejections under 35 U.S.C. § 102

On pages 4-8, the Action rejects claims 1-28 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0069207 to Alexander et al. (hereinafter "Alexander"). Applicants respectfully traverse this rejection.

For at least the following reasons, Alexander does not anticipate claim 1.

Claim 1 recites:

A prompt object on a computer-readable medium used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, the prompt object comprising:

a question to be asked of a user; and
at least one validation property;
wherein the prompt object is used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, and wherein the prompt object is an object separate from the report such that prompt object may be used more than once in a single report or may be used in more than one report.
(Emphasis added).

Alexander does not disclose a prompt object that includes at least one validation property. Specifically, Alexander does not disclose "the prompt object comprising: ... at least one validation property," as recited in claim 1.

On page 5, the Action alleges that Alexander discloses this feature in paragraph [0030]. In this paragraph, Alexander discloses:

Each question will be assigned a set of answers for the user to select. Preferably, there are four types of answers that can be associated with questions: either-or, either-or-other, multiple answer and free text. With an either-or answer, the user may only select one of the possible answers. An either-or-other answer allows the user to select a single suggested answer or to enter a more appropriate answer than those suggested. With a multiple answer question, the user can select as many suggested answers as appropriate. A free text answer does not provide any suggested answers, but allows the user to enter an appropriate answer.

Page 6 of the Action equates the survey of Alexander with the claimed prompt object ("the survey, which is considered the prompt object"). The Action further states that "assigning different types of answers to each question in a survey *implies* a validation of data type for the answer to the question in the survey" (emphasis added). Applicants respectfully disagree.

Contrary to the statement made in the Action, assigning different types of answers to questions in a survey does not imply that the survey includes a validation property for a data type of the answer. It is noted that Alexander does not use the terminology "validation" or "data type." Hence, it appears that the Action is arguing that Alexander's survey *inherently* includes information that validates a "data-type" of the answer. Applicants note that:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Paragraph [0030] does not, however, disclose that Alexander's survey necessarily includes a validation property to validate a "data type" of an answer. This paragraph indicates that a user may: (1) "only select one of the possible answers;" (2) select "a single suggested answer or to enter a more appropriate answer than those suggested;" (3) select "as many suggested answers as appropriate;" or (4) enter a "free text answer [that] does not provide any suggested answers, but allows the user to enter an appropriate answer." Nowhere does paragraph [0030] of Alexander explicitly disclose that the survey includes a validation property for validating data types of answers. Moreover, Alexander does not even disclose any component or program validating "data types" of answers, contrary to the assertion made in the Action. The Action speculates that Alexander's survey includes this feature, however, in light of *In re Robertson*, "[i]nherency. . . may not be established by probabilities or possibilities." *Id.* Thus, the Action has not shown that Alexander's survey includes a validation property to anticipate the feature of "the prompt object comprising: ... at least one validation property," as recited in claim 1. Therefore, claim 1 is believed to be in condition for allowance and allowance thereof is respectfully requested.

Claims 2-5, which depend from claim 1, also are in condition for allowance due to their dependence on an allowable claim.

Independent claims 6, 14, and 21 are allowable for reasons analogous to those given in support of claim 1.

Claims 7-13, 15-20, and 22-28, which respectively depend from claims 6, 14, and 21, also are in condition for allowance due to their dependence on an allowable claim.

Declaration under 37 C.F.R. 1.131

On pages 8-9, the Action states that the "declaration filed 10/2/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Alexander reference." Applicants respectfully disagree.

At this time, however, Applicants preserve the right to challenge this finding and may supplement and/or appeal this finding should a final rejection be issued.

CONCLUSION

Since the cited references, taken either singly or in combination, fail to teach or suggest the combinations set forth in the pending claims, and further fail to provide any motivation or suggestion of the desirability of modifying the structures or methods to arrive at the claimed combinations, Applicants submit that the pending claims are allowable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections, allow the pending claims, and pass the application to issue.

If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

If there are any fees due, including any fees required under 37 C.F.R. §1.116 or §1.117 which are not enclosed herewith, or any fees required for extension of time under 37 C.F.R. §1.136, please charge such fees to our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

By: 

Brian M. Buroker
Registration No. 39,125

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Hunton & Williams, LLP
1900 K Street, N.W.
Washington, DC 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201